



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,762	10/23/2003	John Lawrence Colley	DOMINION 2	6688
31704	7590	09/28/2010	EXAMINER	
Thomas & Karceski, P.C. 536 GRANITE AVENUE RICHMOND, VA 23226			LUBIN, VALERIE	
			ART UNIT	PAPER NUMBER
			3626	
			MAIL DATE	DELIVERY MODE
			09/28/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/691,762	Applicant(s) COLLEY ET AL.	
	Examiner VALERIE LUBIN	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/10 has been entered.

2. Claims 1-3 and 5-10 are pending.

For reference purposes, the document paper number is 20100924.

Response to Amendment

3. The rejection of claims 1-3 and 5-10 under 35 U.S.C. 112 2nd paragraph is maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites "calculating by a computer a value index for the alternative product, the value index being the ratio of an expected premium, as compared with the standard premium, to actual premium of the alternative product." The claim is indefinite as it is unclear what Applicant means by "an expected premium, as compared with the standard premium..." Examiner cannot ascertain which two elements Applicant is using to calculate the claimed ratio.

Claims 2, 3 and 5-10, as dependents of claim 1 are rejected under the same analysis.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. U.S. Patent No. 5,655,085 in view of Buckner et al. Pre-Grant Pub No. 2003/0236685.

9. With respect to claim 1, Ryan teaches a method comprising the step of selecting one or more insurance products with different features such as premiums and benefits (Col. 5 lines 13-20; col. 18 lines 33-36; col. 19 lines 46-53, Fig. 16) which is a form of selecting a standard product and selecting an alternative product; calculating a value index for insurance products (Col. 21 lines 58-60); and using the index to compare the insurance products (Col. 21 lines 58-67; col. 22 lines 1-46).

Ryan does not recite that the index is the ratio of an expected premium to an actual premium; however Bruckner recites the calculation of ratios of expected values over actual values (§ 31). It would have been obvious to one of ordinary skill in the art to add the teachings of Bruckner to Ryan as both teachings would have performed the same functions when combined as individually and produced the same predictable results.

Claim 2 is rejected under the analysis of claim 1.

10. Claim 3 is rejected, as Ryan discloses the insurance product being an incumbent one (Col. 8 lines 9-13; col. 22 lines 52-62).

11. With respect to claim 5, Ryan discloses accounting for differences in co-payment or coinsurance amounts between insurance products (Col. 4 lines 41-46, col. 6 lines 21-28, e.g. conducting sensitivity analysis on the insurance products to account for differences in premium amounts).

Claim 7 is rejected under the analysis of claim 5.

12. With respect to claim 8, Ryan discloses conducting sensitivity analysis on insurance products which is a form of assessment (Col. 6 lines 21-28). The mathematical steps used in conducting such analysis or assessment is a mere substitution of known techniques for others that yield predictable results (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

13. Claim 9 is rejected as Ryan discloses assigning a discretionary premium impact value for a predetermined benefit difference between insurance products (Col. 2 lines 61-63).

14. Regarding claim 10, Ryan teaches a value index being a single number (Fig. 27E).

Response to Arguments

15. Applicant's arguments filed 9/16/10 have been fully considered but they are not persuasive.

16. Applicant argues that the prior art does not suggest or teach "a subjective, comparative use of the term value as currently claimed" and "subjective or three dimensional use of any term as the 'value index'..." Examiner does not understand what Applicant means by such language which furthermore is not mentioned or understood in Applicant's claims. Applicant also argues that the prior art does not disclose or describe a value or value index. Examiner respectfully disagrees as Ryan recites assigning a value to an insurance product (Col. 1 lines 45-49); calculating a value index for insurance products (Col. 21 lines 58-60);

and using the index to compare the insurance products (Col. 21 lines 58-67; col. 22 lines 1-46).

17. In response to applicant's argument that Ryan and Buckner are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the cited prior art resolves the issue of assigning a value to insurance products as well as calculating and using a value index to compare insurance products.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. L./

Examiner, Art Unit 3626

/Robert Morgan/

Supervisory Patent Examiner, Art Unit 3626